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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,556	03/21/2001	Eiichi Ito	108863	2650

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EXAMINER
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LUGO, CARLOS

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/812,556

Applicant(s)

ITO ET AL.

Examiner

Carlos Lugo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on December 29, 2003.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-3,6 and 11-17 are rejected** under 35 U.S.C. 103(a) as being unpatentable over RubberStampsnow.com (Rubber Stamp) in view of CurrentChecks.com (Current Checks), in view of US Pat No 6,134,548 to Gottsman et al (Gottsman) and further in view of US Pat No 6,594,642 to Lemchen.

Regarding claims 1-3,6,12,13 and 16, Rubber Stamp discloses a personalized product producing system comprising an electronic mail receiver that receives emails from different customers. Each email contains data of the requested personalized product along with customer information (Page 2).

However, Rubber Stamp fails to disclose that the email is send by a customer by wireless communication, that two emails will be sent to the customer, one to confirm that the order was receive and one to confirm that the product is completed and that the email data of the personalized product will be electronically analyzed.

Current Checks teaches that is known in the art to have a feedback service that when a person send an email (see Page 10), the system will send an email to the

customer to confirm that the order was receive and another to confirm that the product is completed (see Page 6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a feedback service, as taught by Current Checks, into a system as described by Rubber Stamps, in order to be polite and kind to the customer in order to have him back for further purchases.

As to the fact that Rubber Stamp fails to disclose that the email is send by a customer by wireless communication, Gottsman teaches that it is known in the art the use of cellular or palms devices, known wireless devices, to send and receive emails (Figure 17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a wireless device, as taught by Gottsman, into a system as described by Rubber Stamps, in order to give the customer different ways to enter his order.

And as to the fact that the email data of the personalized product will be electronically analyzed, Rubber Stamps discloses that the company will receive an email with the customize data to be created.

Lemchen teaches that is known in the art to have an electronic data analyzer (50) that receives customize data from a web server (60) and converts the data to an electronic data that the personalized product-producing device (10) receives in order to output the product.

Applicant is reminded that the replacement of a manual operation with an automatic operation is a design consideration within the skill of the art. In re Venner, 262 F.2d 91, 120 USPQ 192 (CCPA 1955).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to automate the process, as taught by Lemchen, into a system as described by Rubber Stamps, in order to increase and to make agile the production.

As to claim 11, Rubber Stamp discloses that the personalized product-producing device produces an engraved stamp (see Page 1, list of products).

As to claims 14 and 15, Rubber Stamps fails to disclose that the product produced are name cards or sticker/labels. Rubber Stamps produce personalized stamps (see Page 1).

Current Checks teaches that the personalized product-producing device produces a name card or a sticker/label (see Page 9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make name cards or sticker/labels, because the product will not affect the process of receiving the order from the customer. Furthermore, it also could be obvious to Rubber Stamps produce name cards or sticker/labels in order to expand their personalized products and bring more customers to make purchases.

As to claim 17, Rubber Stamp discloses a plurality of types or designs (see Pages 3 and 4).

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4. **Claim 4 is rejected** under 35 U.S.C. 103(a) as being unpatentable over RubberStampsnow.com (Rubber Stamp) in view of CurrentChecks.com (Current Checks), in view of US Pat No 6,134,548 to Gottsman et al (Gottsman), in view of US Pat No 6,594,642 to Lemchen and further in view of US Pat No 6,535,294 to Arledge et al (Arledge).

Rubber Stamps, as modified by Current Checks, Gottsman and Lemchen, fails to disclose that the system further includes a storage device.

Arledge teaches that is known in the art to have a personalized product producing system wherein when an user already use the system to create a personalized product, the system includes a storage device (224) in order to store any information concerning the user and previously products created by the user (Col. 2 Line 66 to Col. 3 Line 6 and Col. 13 Lines 14-32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a storage device, as taught by Arledge, into a system as described by Rubber Stamps, as modified by Current Checks, Gottsman and Lemchen, in order to store any information of the user for future purchases.

5. **Claims 5 and 7-9 are rejected** under 35 U.S.C. 103(a) as being unpatentable over RubberStampsnow.com (Rubber Stamp) in view of CurrentChecks.com (Current Checks), in view of US Pat No 6,134,548 to Gottsman et al (Gottsman), in view of US Pat No 6,594,642 to Lemchen, in view of US Pat No 6,535,294 to Arledge et al (Arledge) and further in view of US Pat No 5,732,398 to Tagawa.

Rubber Stamps, as modified by Current Checks, Gottsman, Lemchen and Arledge, fails to disclose that there is more than one location where the email of the customer can be send and that the personalized product producing system is installed in an amusement facility and the email receiver is installed in a plurality of pavilions.

Tagawa teaches that is known in the art to have a network (Figure 2a) with more than one location (50,54 and 60) and a plurality of pavilions (Regional Reservation Centers 1-3), wherein a person can send an email (request for travel information) through the different locations (kiosks 50,54 and 60) to another regional centers (Col. 8 Line 51 to Col. 9 Line 33). Also, the personalized product producing system (kiosk) is installed in an amusement facility (geographical region with dense population centers or with many local tourist attractions, Col. 8 Lines 51-62).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have more than one location, as taught by Tagawa, into a system as described by Rubber Stamps, as modified by Current Checks, Gottsman, Lemchen and Arledge, in order to give the customer a diversity of places where he can send his order conveniently.

6. **Claim 10 is rejected** under 35 U.S.C. 103(a) as being unpatentable over RubberStampsnow.com (Rubber Stamp) in view of CurrentChecks.com (Current Checks), in view of US Pat No 6,134,548 to Gottsman et al (Gottsman), in view of US Pat No 6,594,642 to Lemchen and further in view of US Pat No 5,495,430 to Matsunari et al (Matsunari).

Rubber Stamps, as modified by Current Checks, Gottsman and Lemchen, fails to disclose that the system further includes an estimated time calculator.

Matsunari teaches that is known in the art to have an estimated time calculator that will estimate the time that the process will take depending on the product to be made it (Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have an estimated time calculator, as taught by Matsunari, into a system as described by Rubber Stamps, as modified by Current Checks, Gottsman and Lemchen, in order to inform the customer how long it would take the production of the product.

#### ***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's arguments that the Currents Checks reference does not indicate any publication date (Page 18 Line 24), Current Checks indicates a publication date. At the left bottom, the publication date is March 8, 2000 (20000308).

This publication date is provided, as explained to the applicant's representative, by an Internet tool, the Internet Archive. The Internet Archive is a public nonprofit that was founded to build an "Internet library" with the purpose of offering permanent access for researchers, historians and scholars to collections that exist



in digital format. In other words, the Internet Archive is a library that provides the archive version of the web at a certain time.

In order to obtain a back archive of the Checks Unlimited site, the examiner wrote down in the search blank "www.checksunlimited.com. The Internet Archive found that Checks Unlimited site is provided since October 1, 1999, but for the examination, it was consider the one dated on March 8, 2000. In order to obtain the data of that site at that time, the examiner just clicks on that date. Then the Internet Archive will provide that site at that time. The name of the company at that time was Current Checks. The data that was provided in the previous action is the data founded after examining the archive. Therefore, the examiner proves that the Checks Unlimited reference is good for the examination of this application.

As to applicant's arguments that the first page of the Checks Unlimited reference has no publication date (Page 20 Line 3), as mentioned in the personal interview with the applicant's representative, this first page is just a courtesy from the examiner to prove that both companies, Current Checks and Checks Unlimited are the same.

As to applicant's arguments that Rubber Stamps Now.com and Print USA fails to provide a publication date (Page 21 Line 21), see the argument to Current Checks or Checks Unlimited above.

As to applicant's arguments that Rubber Stamps fail to disclose an email receiver that receives emails from different customers (Page 22 Line 18), Rubber Stamps clearly disclose that the system receive emails (Page 2).

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As to applicant's arguments regarding inherency (Page 23 Line 2), applicant is reminded that where there is reason to believe that a functional limitation asserted to be critical to establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, Applicant may be required to prove that the subject matter shown in the prior art does not possess the characteristic relied upon. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986); In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596-97 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971).

As to applicant's arguments that Rubber Stamps fail to show acknowledgement of receipt of the email (Page 23 Line 13), Current Checks teaches this limitation (see rejection above).

As to applicant's arguments that Rubber Stamps fails to disclose an electronic data analyzer (Page 23 Line 18), Lemchen teaches this limitation (see rejection above).

As to applicant's arguments that Current Checks fail to disclose a feedback service (Page 24 line 15), Current Checks disclose this limitation. Clearly, Current Checks teaches that an email confirmation will be send it to the customer (page 6).

As to applicant's arguments that Gottsman fails to disclose the context of the claimed invention (Page 25 Line 3), Gottsman is only used to demonstrate that is

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well known in the art to use wireless communication (cell phone, palm, etc) to send emails. In other words, that now, at the time the invention was made, it was well known the use of wireless communication to perform a shopping transaction.

As to applicant's arguments that Tagawa fails to disclose that there is more than one location where the email of the customer can be send and that the personalized product producing system is installed in an amusement facility and the email receiver is installed in a plurality of pavilions (Page 25 Line 19), Tagawa teaches this limitation (see rejection above). Furthermore, applicant is reminded that the duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (Page 25 Line 23), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As to applicant's arguments that Kara fails to disclose the invention as claimed (Page 26 Line 4), the rejection is withdrawn.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

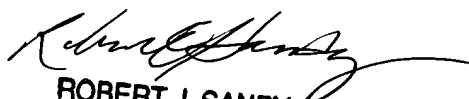
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Carlos Lugo  
Examiner  
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March 18, 2004.

  
ROBERT J. SANDY  
PRIMARY EXAMINER